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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,083	10/01/2004	Chi-Ping Tseng	BA9302USPCT	4238
<div>7590 11/01/2007 E I du Pont de Nemours and Company Legal - Patents 4417 Lancaster Pike Wilmington, DE 19898</div>			<div>EXAMINER PRYOR, ALTON NATHANIEL</div>	
			<div>ART UNIT 1616</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 11/01/2007</div>	<div>DELIVERY MODE PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/510,083

Applicant(s)

TSENG, CHI-PING

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-30 is/are allowed.
- 6) ☒ Claim(s) 11-15, 22 and 31 is/are rejected.
- 7) ☒ Claim(s) 16-21 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's arguments, see paper, filed 8/13/07, with respect to the rejection(s) of claim(s) under 102(b) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is set forth below.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-15, 18, 22 are no longer rejected under 35 U.S.C. 102(b) as being anticipated by Gall et al (Arylformamidines with Antinociceptive Properties, J. Med. Chem., 1988, 31, 1816-1820). Gall teaches a compound 3c which is identical to the instant compound of formula I where  $m = 1$ ,  $R_1 = H$ ;  $R_2, R_3, R_4$  and  $R_5 = Me$ ;  $A = a$  direct bond;  $R_6 = CH(Me)$ ; and  $R_{12} = CO_2Et$ . The compound is in composition form since the compound is formulated as a reaction mixture. Note, in a claim to a composition, a statement to the composition's intended use has no patentable significance.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14, 22 are no longer rejected under 35 U.S.C. 103(a) as being unpatentable over Emura et al (JP 10095762; 01/05/98). See ABS. Emura teaches the compound ethanaimidamide N-[3-aminomethyl)-2-methylphenyl] dihydrochloride. This compound is the instant compound of formula (I) where R<sub>1</sub>,R<sub>4</sub> = Me; R<sub>2</sub>,R<sub>3</sub> = H; R<sub>6</sub> = CH<sub>2</sub>; R<sub>12</sub> = NH<sub>2</sub>; and m = 0. The compound taught by Emura differs from instant compound in that Emura teaches that R<sub>12</sub> is NH<sub>2</sub> whereas in instant claims R<sub>12</sub> can be NHCH<sub>3</sub> instead. Therefore Emura teaches a compound differing from instant compound by having H attached to the NH instead having Me attached to the NH. It would have been obvious at the time of Emura's invention to have made a compound having the Me instead of the H attached to the NH. One would have been motivated to do this because H and Me have similar chemical and physical properties and therefore both compounds would have been expected to yield a similar activity when applied in the same application. The compound of Emura would have obviously been placed in some sought of medium. On this basis, it is obvious that the compound would have been formulated into a composition.

*Reason for the withdrawal of the above rejections*

The rejected claims were amended to remove a single bond as a possibility in the definition of the "A" moiety.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-15,22,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugizaki et al (JP 04279562; 10/05/92). Sugizaki teaches a compound that is structurally similar to an instant compound of formula I where A = oxygen, R6 = methylene, R4,R5 = t-butyl, R1 = SH, R2 = H, R3 = t-butyl, R12 = C(O)OMe. See abstract. Sugizaki compound differs from instant compound in R12. Note that Sugizaki's teaches the compound where R12 = C(O)OCH3 whereas instant invention discloses that R12 = C(O)OH. The functional groups differ in H versus Me, which are chemically and physically equivalent. For this reason it would have been obvious to replace H with Me vice versa. One would have been motivated to do this because H and Me possess similar chemical and physical properties.

Claims 11-15,22,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al (USPN 5521145; 5/28/96). Takano teaches a compound that is structurally similar to an instant compound of formula I where A = sulfur, R6 = methylene, R4,R5 = Cl,F; R1 = SH, R2 = H, R3 = Me, R12 = C(O)OMe. Takano's compound differs from instant compound in R12. See columns 8-9. Note that Takano's teaches the compound where R12 = C(O)OCH3 whereas instant invention discloses that R12 = C(O)OH. The functional groups differ in H versus Me, which are chemically and physically equivalent. For this reason it would have been obvious to replace H with Me vice versa. One would have been motivated to do this because H and Me possess similar chemical and physical properties.

***Claim Objection / Allowable Subject Matter***

Claims 16-21,23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 25-30 are allowable. The prior art does not teach or suggest the compound where R6 is instant C6-15 alkyl, C5-15 2-alkenyl, and silyl substituent. The prior art does not teach or suggest the combination of instant compounds with a fungicide. The prior art does not teach or suggest a method of using instant compound to control plant disease caused by fungi. Claims 25-30 are allowable. The prior art does not teach or suggest the compound where R6 is instant C6-15 alkyl, C5-15 2-alkenyl or substituted C1-C4 alkyl.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

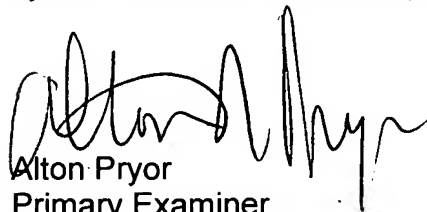
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***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alton Pryor  
Primary Examiner  
AU 1616